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TO: Commissioner for Patents  
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FROM: Jason S. Feldmar  
OUR REF.: G&C 30566.128-US-01  
TELEPHONE: (310) 642-4141

Total pages, including cover letter: 2


PTO FAX NUMBER: **571-273-8300**

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Title of Document Transmitted:	TRANSMITTAL SHEETS, NOTICE OF APPEAL, PRE-APPEAL BRIEF REQUEST FOR REVIEW FORM PTO/SB/33, AND PRE-APPEAL BRIEF REQUEST FOR REVIEW ARGUMENTS.
Applicant:	Kenneth L. Davis
Serial No.:	09/862,884
Filed:	May 21, 2001
Group Art Unit:	2176
Title:	METHOD AND APPARATUS FOR ANNOTATING A SEQUENCE OF FRAMES
Our Ref. No.:	G&C 30566.128-US-01

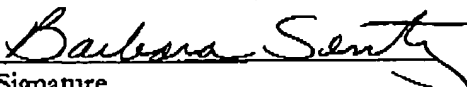
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Due Date: September 2, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Kenneth L. Davis	Examiner:	Quoc A. Tran
Serial No.:	09/862,884	Group Art Unit:	2176
Filed:	May 21, 2001	Docket:	G&C 30566.128-US-01
Title:	METHOD AND APPARATUS FOR ANNOTATING A SEQUENCE OF FRAMES		

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I hereby certify that this correspondence is being filed via facsimile transmission to the U.S. Patent and Trademark Office on September 1, 2005.

By:   
Name: Jason S. Feldmar

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

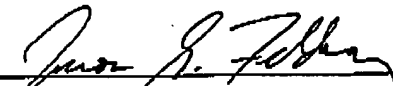
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- ☒ Transmittal sheet, in duplicate, containing a Certificate of Mailing or Transmission under 37 CFR 1.8.
- ☒ Notice of Appeal.
- ☒ Charge the Fee for the Notice of Appeal in the amount of \$500.00 to the Deposit Account.
- ☒ Pre-Appeal Brief Request for Review Form PTO/SB/33.
- ☒ Pre-Appeal Brief Request for Review Arguments.

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Customer Number 22462  
**GATES & COOPER LLP**  
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6701 Center Drive West, Suite 1050  
Los Angeles, CA 90045  
(310) 641-8797

By:   
Name: Jason S. Feldmar  
Reg. No.: 39,187  
JSF/bjs

G&amp;C 30566.128-US-01

SEP 01 2005

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) G&C 30566.128-US-01	
I hereby certify that this correspondence is being filed via facsimile transmission to the U.S. Patent and Trademark Office under 37 CFR 1.8 on <u>September 1, 2005</u> Signature <u>Barbara Senty</u> Typed or printed name <u>Barbara Senty</u>		Application Number <b>09/862,884</b>	Filed <b>May 21, 2001</b>
		First Named Inventor <b>Kenneth L. Davis</b>	
		Art Unit <b>2176</b>	Examiner <b>Quoc A. Tran</b>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. <b>39,187</b> Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> Total of _____ forms are submitted.</p>			
<p>Signature <u>Jason S. Feldmar</u> Typed or printed name <b>Jason S. Feldmar</b> Telephone number <b>(310) 641-8797</b> Date <b>September 1, 2005</b></p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Due Date: September 2, 2005

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Kenneth L. Davis	Examiner:	Quoc A. Tran
Serial No.:	09/862,884	Group Art Unit:	2176
Filed:	May 21, 2001	Docket:	G&C 30566.128-US-01
Title:	METHOD AND APPARATUS FOR ANNOTATING A SEQUENCE OF FRAMES		

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PRE-APPEAL BRIEF REQUEST FOR REVIEW ARGUMENTS

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated June 2, 2005, and the Advisory Action dated August 12, 2005, Applicants hereby submit a Notice of Appeal accompanied by a Pre-Appeal Brief Request for Review. The claims have not been amended.

Independent claims 1, 9, and 17 are generally directed to annotating a video clip/sequence of frames. A computer program obtains a video clip and annotation information that identifies a particular frame in the video clip, an annotation, and a location on the particular frame to display the annotation. The computer program proceeds to display the sequence of frames and then determines (automatically) when the particular frame is displayed at which point the program automatically pauses the display. The annotation is then displayed at the specified location. The video clip remains paused until the user elects to proceed at which point the sequence of frames then continues to display.

Appellants submit that based on the claims and cited art, there are clear errors in the examiner's rejections and further, the rejections fail to establish essential elements needed for a prima facie rejection.

Independent Claims 1, 9, and 17 - Failure to Establish Prima Facie Case under 35 U.S.C. §103

Appellants direct the panel to pages 8-12 of the Request for Reconsideration filed by Appellant on August 2, 2005 for the substance of the arguments. Based on such arguments, Appellants submit that there is clear error in the examiner's rejection.

Automatically Pausing a Display of a Sequence of Frames at an Identified Frame

Appellants direct the attention of the panel to pages 8-12 of the Request for Reconsideration for the substance of the arguments. More specifically, Appellants direct the panel to pages 10-11 of the Request for Reconsideration directed towards the lack of teaching in Ubillos. Appellants reassert that the word "automatic" and "pause" as used in the claims is not addressed in the final Office Action or the Advisory Action. The Advisory Action merely refers to Ubillos, in or out points in a clip, selecting a special effect transition between clips, and to control superimposition of an overlay clip with a main clip in response to manipulation of a level control icon. However, even assuming that Ubillos teaches such features, such features still fail to address the specifically claimed "automatic pause" set forth in the claims.

Again, under MPEP §2142 and 2143.03, all words in a claim must be considered. Neither the final Office Action nor the Advisory Action address the "automatic pausing" set forth in the independent claims. Accordingly, there are clear errors in the examiner's rejections and the examiner has omitted essential elements needed for a prima facie rejection under 35 USC §103.

Displaying an Annotation at a Particular Location on an Identified Frame

Appellants direct the attention of the panel to page 11 of the Request for Reconsideration for the substance of the arguments.

Appellants submit that there is clear error in that the final Office Action fails to submit where Ubillos teaches the continued display of an annotation on a particular frame as claimed instead of displaying every Nth frame. Accordingly, the Office Action omits an essential element needed for a prima facie rejection.

Continued Display of Sequence of Frames When User Elects to Proceed

Appellants direct the attention of the panel to pages 11-12 of the Request for Reconsideration for the substance of the arguments.

Appellants submit that there is clear error in that the final Office Action fails to submit where Ubillos teaches the continued display of an annotation on a particular frame when the user elects to proceed (after the automated pausing) as claimed instead of filtering video data with a time-varying mosaic filter. Accordingly, the Office Action omits an essential element needed for a prima facie rejection.

Dependent Claims 7, 15, and 23- Failure to Establish Prima Facie Case under 35 U.S.C. §103

Appellants refer the panel to page 12-13 of the Request for Reconsideration regarding the substance of the arguments. Namely, Gupta's mere mention of the use of XML does not teach or disclose the specifically claimed elements relating to using XML to define each of the annotation information elements as set forth in the claims. Thus, the Office Action contains a clear error and omits an essential element of the claims necessary to establish a prima facie rejection.

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP  
Attorneys for Appellant(s)

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Name: Jason S. Feldman  
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